

REMARKS

Upon entry of the amendments, claims 1-18 will be pending in the application.

Applicants provide the following comments.

Election

Applicants confirm the election of Group I, which includes claims 1-18. Applicants have canceled the claims of Group II from the application. The non-elected claims will be pursued in a divisional application.

Claim Rejection – 35 U.S.C. § 102

Claim 1 is rejected under 35 U.S.C. §102(b) as being allegedly anticipated by anticipated by Hiles (US 4,626,604).

Applicants respectfully request that the rejection be withdrawn because the cited patent fails to inherently or explicitly disclose all the feature set forth in claim 1. Applicants respectfully assert that the cited patent fails to disclose “recirculating a reaction mixture containing the substance to be hydrogenated, hydrogenation product, hydrogen and hydrogenation catalyst suspended in the reaction mixture in a reactor”.

Applicants note that Hiles solely discloses hydrogenation reactions performed in the gas phase using fixed bed catalysts. Therefore, the process of claim 1 is patentably distinguishable from the process disclosed by Hiles.

Claim Rejections – 35 U.S.C. § 103

The following obviousness rejections are set forth in the Office Action of September 15, 2003:

1. claims 1-18 are rejected as obvious in view of Bengtsson (US 5,063,043) and Devic (US App. No. 2003/0086853); and
2. claims 1-18 are rejected as obvious in view of Turunen (US 5,637,286) and Welp (US App. No. 2003/0050510).

Regarding the first rejection, Applicants do not believe that the Devic application is proper prior art. The Devic application was filed in French as a PCT application on February 15, 2001. Because the application was not filed in English, the international filing date can not be relied upon in determining whether the claimed invention is obvious. Furthermore, the priority date of the present application is October 21, 2000, which is prior to the international filing date of the Devic application. Applicants have filed an English translation of the present application's priority document for the Examiner's consideration.

Regarding the second rejection, the Welp application is not proper prior art because it was filed on August 30, 2001. As discussed above, the present application claims a priority date of October 21, 2000 and Applicants have filed an English translation of the priority document.

Applicants request that the above referenced rejections be withdrawn.

Double Patenting

Applicants note that the Examiner has issued a provisional rejection of claims 1-18. From a review of the United States Patent and Trademark Office records, it appears that Application No. 09/825,853 will not mature into a patent. As such, Applicants believe that a rejection should not be issued.

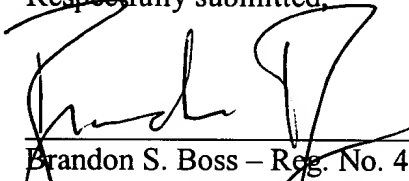
CONCLUSION

Applicants respectfully request allowance of the application. If any additional fees are due in connection with the filing of this response, such as fees under 37 C.F.R. §§ 1.16 or 1.17, please charge the fees to Deposit Account No. 02-4300. Any overpayment can be credited to Deposit Account No. 02-4300.

Respectfully submitted,

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Signature:



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